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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/851,601	05/09/2001	Timothy W. Skszek	POM-12102/29	2583

7590 06/13/2003

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EXAMINER
FULLER, ERIC B

ART UNIT	PAPER NUMBER
1762	12

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/851,601	SKSZEK ET AL.	
	Examiner	Art Unit	
	Eric B Fuller	1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached Office Action*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-5*.

   Claim(s) withdrawn from consideration: *6-10*.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant argues that the examiner has improperly withdrawn the examination of claims 6-10, being drawn to a product. In support, the applicant argues that since the claims are dependent on the method claims, the product of claims 6-10 must be made by the methods of claims 1-5. Applicant asserts that by assuming that "optically monitoring", as set forth in the rejected method claims, represents some sort of improvement that would enhance the physical dimensions of the tooling during fabrication, the tooling set forth in the proposed claims could only be made by the process set forth in the claims from which they depend. This argument is not found persuasive.

The claimed method involves optical monitoring for feedback control. It is the position of the examiner that a part produced by such a method would not be patentable distinguishable from a part that did not use optical monitoring for feedback control in it's method of manufacturing.

Within the specification, it is noted that optical monitoring for feedback control is used in order to possess close control of dimensions, which is necessary for the production of parts and tools having close tolerances, acceptable microstructures and properties, and which can be produced at a reasonable cost and within a reasonable period of time (page 3, last paragraph). The benefit of reasonable cost and time pertains only to improvements in the method, and therefore would not distinguish a

product made from a method that did not use optical monitoring from a product made by the method of claim 1. Although the benefit of close control of dimensions during the forming process *could* have an effect in the product, the applicant has admitted in the above-cited paragraph that this is only necessary, and thus only distinguishable, for parts or tools having close tolerances. This idea of close tolerance is not present in any of the claims. The following is an example of how two different processes may be used to produce a product that would read on the product claims of the present invention.

Kar et al. (US 6,203,861 B1) teaches a process that produces a part that has acceptable microstructure and properties. This process differs from the present invention in that it does not use optical monitoring for feedback control. The claimed process of the application could be used to produce an exact duplicate part as the one in Kar, with the benefits discussed above. Although the increased control of the claimed method may increased the reproducibility of producing each product, a single part produced by Kar and the exact duplicate produced by the process of the present invention would be indistinguishable. From this, the examiner has proven, as applicant has requested, that two different methods may be used to form the same part, wherein only one of the processes reads on the applicant's method. Therefore, the restriction, and withdrawal by original presentation, of claims 6-10 is proper.

As the applicant has not argued the rejections of claims 1-5, they are presumed to be proper and the finality of the previous Office Action is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached at (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

EBF
June 10, 2003

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700